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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,279	12/21/2001	Earle H. Sherrod	17,722	3072

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EXAMINER

CHEN, VIVIAN

ART UNIT PAPER NUMBER

1773

DATE MAILED: 11/04/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

CLO 10

<b>Office Action Summary</b>	Application N .		Applicant(s)	
	10/027,279		SHERROD ET AL.	
	Examiner		Art Unit	
	Vivian Chen		1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6, 8, 9</u> | 6) <input type="checkbox"/> Other:  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The rejections under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicant's amendments filed 7/21/2003.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-21 of copending Application No. 10/026,197 (allowed) in view of:

(a) WO 99/45834 (hereinafter WO '834); or

(b) GERMAN PUBLICATION 20016916U1 (hereinafter DE '916) and CANADIAN

PATENT 819,353 (hereinafter CA '353).

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Application No. 10/026,197 claims a multilayer dispersible film as recited in application claims 11-21. However, the copending Application fails to explicitly disclose the recited commode liner structure.

WO '834 discloses toilet or commode liners comprising two opposing members joined together so as to form a liner with an open top, wherein the liner having a trapezoidal shape which is wider at the top than at the bottom (Figures 28-30, 31, 32, 34).

DE '916 discloses a toilet liner with an open top, wherein the liner having a trapezoidal shape which is wider at the top than at the bottom.

CA '353 discloses that it is well known in the art to form liners for containing bodily waste from two sheets joined together to form a container with an open top (lines 15-16, page 4)..

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a flushable and dispersible barrier laminate as claimed in copending Application No. 10/026,197 to form conventional disposable articles such as tapered toilet liners as disclosed in WO '934 and DE '916. It also would have been obvious to form such liners by joining two opposing members as illustrated in CA '353. One of ordinary skill in the art would have adjusted the dimensions and the mechanical and solubility properties of the liner in order to obtain the desired flushing, durability, impermeability, and capacity for a given application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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*Claim Rejections - 35 USC § 102*

4. The rejections under 35 U.S.C. 102(b) has been withdrawn in view of Applicant's amendments filed 7/21/2003.

*Claim Rejections - 35 USC § 103*

5. Claims 1-10, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/45834 (hereinafter WO '834).

WO '834 discloses impermeable toilet or commode liners comprising two opposing members joined together so as to form a liner with an open top, wherein the liner having a trapezoidal shape which is wider at the top than at the bottom (Figures 28-30, 31, 32, 34), the width of the liner is less than 8 inches (20 cm) at the bottom (Figures 29, 31), and wherein the liner is flushable. However, the reference does not explicitly disclose the recited hydrohead values.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to select the dimensions and materials of the liner in order to obtain the desired flushing, durability, impermeability, wet strength, and capacity for given usage conditions.

6. Claims 1-2, 5, 7-10, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over GERMAN PUBLICATION 20016916U1 (hereinafter DE '916) in view of CANADIAN PATENT 819,353 (hereinafter CA '353).

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DE '916 discloses a toilet liner with an open top, wherein the liner having a trapezoidal shape which is wider at the top than at the bottom. However, the reference does not explicitly disclose two opposing members joined together.

CA '353 discloses that it is well known in the art to form liners for containing bodily waste from two sheets joined together to form a container with an open top (lines 15-16, page 4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form a tapered toilet liner as disclosed in DE '916 by a conventional method such as joining two opposing sheets as illustrated in CA '353. One of ordinary skill in the art would have selected the dimensions and materials of the liner in order to obtain the desired flushing, durability, impermeability, wet strength, and capacity for given usage conditions.

### *Response to Arguments*

7. The rejections under 35 USC 103(a) based on ZHAO ET AL has been withdrawn in view of Applicant's arguments filed 7/21/2003.

8. Applicant's arguments filed 7/21/2003 have been considered but not deemed persuasive.

(A) Applicant argues that WO '834 teaches away from the claimed invention because the prior art liners are liquid permeable, are made of paper, and are not flushable. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., not made of paper, or are flushable, or flushable under certain flushing conditions) are not recited in a majority of the rejected claim(s).

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, WO '834 clearly discloses that the disclosed liners can be impermeable to liquid (page 2) and (with respect to claims 3-4, 6) that liners made from certain types of tissue are in fact flushable (page 6). Applicant has not provided probative evidence that the liners disclosed in WO '834 are wholly incapable of being flushed or dispersed under the recited conditions.

(B) Applicant argues that WO '834 and DE '916 fail to disclose the recited hydrohead value. However, one of ordinary skill in the art would have readily determined the optimum balance between liquid impermeability and flushability required for specific commodes and flushing conditions. Applicant has not provided any probative evidence of unexpected results from the recited hydrohead values.

(C) Applicant argues that DE '916 teaches away from the claimed invention because the prior art liners are made of paper, and are not flushable and dispersible. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., not made of paper, or are flushable, or flushable under certain flushing conditions; etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, WO '834 clearly discloses that the disclosed liners can be impermeable to liquid (page 2) and that liners made from certain types of tissue are flushable (page 6). Applicant has

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not provided probative evidence that the liners disclosed in WO '834 are incapable of being flushed under the recited conditions.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

October 31, 2003



Vivian Chen  
Primary Examiner  
Art Unit 1773